

REMARKS

Claims 1-10 are pending in the above-identified application. Support for the change to claim 9 is found at the bottom of page 15 and pages 17-20 of the present specification. The changes to claims 5 and 7 are minor in character. No new matter has been added.

Unity of Invention Requirement

The Office Action of May 22, 2008 indicates that the Unity of Invention Requirement has been made "Final". Applicant respectfully maintains a traversal of this Requirement based on the reasons stated in the Response filed April 9, 2008 and respectfully requests that the Requirement be withdrawn.

Title and Specification Arrangement Issues

The Title has been objected to as failing to be sufficiently descriptive. In addition, it is suggested in the Office Action that sub-headings be inserted into the Specification. In accordance with the helpful suggestions stated in the Office Action, the Title and Specification have been amended. It is respectfully requested that the Patent Examiner approve of these changes.

Sequence Listing Issue

On May 22, 2008 the USPTO mailed to applicants' representative a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures. Applicants believe that the notification was mailed in error. Should the Commissioner disagree, applicants request the Office to specifically point out each page and line number that is not compliant with the above-mentioned requirement.

Issues under 35 USC § 112

Claim 9 has been rejected under 35 USC § 112, first paragraph, as allegedly failing to satisfy the enablement requirement. It is submitted that claim 9 has been amended so as to clearly indicate

that the claimed “seed” is coated with a compound of formula I rather than involving the DNA of the seed with the fungicidal compounds of the present invention. Consequently, it is requested that the above-noted rejection be withdrawn.

Issues under 35 USC § 102(b) and § 103(a)

Claims 1-3, 5 and 8 have been rejected under 35 USC § 102(b) as being anticipated by (or lacking novelty over) Eicken '303 (USP 4,617,303).

Claims 4 and 9 have been rejected under 35 USC § 103(a) as being unpatentable over Eicken '303 in view of Fox '376 (USP 3,278,376).

The above-noted rejections are traversed based on the following reasons.

Distinctions over Eicken '303 Disclosure

Eicken '303 discloses pyrimidines of formula I as described, for example, at column 1, lines 14-52. A careful review of the disclosure of Eicken '303 clearly indicates that the substituent R² is limited to “C₁-C₄-alkyl” as noted at column 1, lines 43-45.

Eicken '303 fails to disclose or suggest any compounds falling within formula I of the claims of the present application, since corresponding substituent R² of formula I of the present invention is C₅-C₁₂-alkyl. Thus, there is no overlap between R² of Eicken '303 (C₁-C₄-alkyl) and R² of the claims of the present application (C₅-C₁₂-alkyl).

In view of the above, it is clear that the anticipation rejection under 35 USC § 102(b) must be withdrawn.

Additional Evidence Support Patentability over Cited Combination of References

In addition to the above, it is submitted that the claimed compounds of the present invention exhibit unexpected, advantageous properties over comparative examples based on Eicken '303.

In this regard, Applicant hereby submits a Declaration under 37 CFR § 1.132 (hereinafter the "Haden Declaration"). The Haden Declaration shows the: (1) Invention Examples A-1 from Table 5 and A-1 from Table 8 of the present specification exhibit unexpectedly advantageously improved fungicidal infection suppression in contrast to Example 25 from Eicken '303; and (2) Invention Example A-9 from Table 2 exhibits unexpectedly advantageously improved fungicidal infection suppression over Examples 16 from Eicken '303. Note from the structures illustrated at pages 2 and 3 of the Haden Declaration that the structural differences among these examples are very small with respect to the size of the alkyl group at the "R²" position. It is submitted that these comparative test establish that this difference in structure from the compounds of Eicken '303 results in unexpected, advantageous properties. Thus, even assuming hypothetically that Eicken '303 provides a proper basis for asserting *prima facie* obviousness, such obviousness has been rebutted by the evidence of comparative test in the Hayden Declaration. In addition, it is submitted that this evidence essentially eliminates the presumed expectation that the compounds of Eicken '303 possess similar properties as the compounds of the present invention such that the attempt to argue obviousness based on homologous structure necessarily fails. Thus, the rejections above based on Eicken '303 and/or Eicken '303 and Fox '376 must be withdrawn.

The cited Fox '376 disclosure is much farther removed from the present invention than Eicken '303 such that the all of the above-noted distinctions also apply to Fox '376. Fox '376 discloses completely different compounds from those of Eicken '303 such that these references can not be combined. Thus, the rejection based on Eicken '303 and Fox '376 must also be withdrawn for this additional reason.

Double Patenting Issues

Claims 1-5, 8 and 9 have been provisionally rejected based on obviousness-double patenting as being unpatentable over certain claims of each of: (1) Co-pending Application No. 10/589,953; and (2) Co-pending Application No. 10/589,876. It is respectfully requested that these "provisional" double patenting rejections be withdrawn until at least one of the above-noted two

applications or the present application is placed into condition for allowance. Until that point, the scope of the claims of each of these applications may change such that it is premature to address this double patenting issue at this time.


It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 22, 2008

Respectfully submitted,

By  48,101
Andrew D. Meikle
Registration No.: 32,868
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Enclosure: Hayden Declaration under 37 CFR 1.132